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EXAMINER

TRUONG, THANHNGA B

ART UNIT	PAPER NUMBER
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2135

NOTIFICATION DATE	DELIVERY MODE
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07/29/2008

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No. 10/773,974	Applicant(s) TWEDE, ROGER SCOTT	
	Examiner Thanhnga B. Truong	Art Unit 2135	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 April 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,4-8,10,11,19-22 and 33-39 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,4-8,10,11,19-22 and 33-39 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is responsive to the communication filed on April 15, 2008. Claims 1-2, 4-8, 10-11, 19-22, 33-39 are pending. Claims 3, 9, and 12-18, and 23-32 are canceled by the applicant. At this time, claims 1-2, 4-8, 10-11, 19-22, 33-39 are still rejected.

Response to Arguments

2. Applicant's arguments with respect to claims 19-39 under 35 USC 103 have been considered but are moot in view of the new ground(s) of rejection.

Applicant's arguments with respect to claims 33-39 under 35 USC 101 have been considered but they are not persuasive. Applicant's specification (see page 2, lines 19-24 of specification) is still showing **"the functions described herein are implemented in software in one embodiment, where the software comprises computer executable instructions stored on computer readable media such as memory or other type of storage devices. The term "computer readable media" is also used to represent carrier waves on which the software is transmitted. Further, such functions correspond to modules, which are software, hardware, firmware of any combination thereof,"** which clearly including intangible media such as signals, carrier waves, transmissions, optical waves, transmission media or other media incapable of being touched or perceived absent the tangible medium through which they are conveyed. Therefore, claim 33 recites a non-statutory subject matter.

Applicant's arguments with respect to claims 1-2, 4-8, and 10-11 under 35 USC 103 have been considered but they are not persuasive.

Applicant argues that:

"Applicant submits that neither Botham, Ginter, or Holloway teach, disclose, or suggest the limitation that "the original document is destroyed at the system of the sender only after the system of the sender has received assurance that the system of the recipient has received transmission of the image of the original document," such that Botham in combination with Ginter and Holloway cannot be considered as teaching, disclosing, or suggesting all the claim limitations of claim 1."

Examiner respectfully disagrees with the applicant and still maintains that:

Botham teaches an arrangement for secure and controlled electronic distribution of documents from a server (102) to clients (101) across an electronic network (100), e.g., the Internet. A client requests (200) authentication from the server. The server validates (202) the request and sends (206) a validation and encryption data (129) to the client to establish a secure communications connection with the client. The client returns (210) a request for a document accompanied by the client ID (131) to the server. The server validates (212) the request and uses the client ID to set (216) permissions of the client for the document. The server then uses the encryption data to encrypt (220) the document and its permissions, and sends (224) the encrypted information to the client. The client acknowledges (230) receipt of the document, decrypts (228) it by using the encryption data, and enforces (232) the permissions on the document. The client reports (234) any activity at the client with respect to the document to the server. The server makes a record (236) of the acknowledgement of receipt and of the reports of activity for the document. Although Botham teaches the claimed subject matter, Botham is silent on the capability of showing the destroyed document is at the system of the sender and by at least a public notary notarizing the copy of the image of the original document. On the other hands, Ginter teaches the original document is destroyed at the system of the sender only after the system of the sender has received assurance that the system of the recipient transmission of the image of the original document **(column 8, lines 12-14 of Ginter)** and Holloway teaches by at least a public notary notarizing the copy of the image of the original document **(column 1, lines 21-22 of Holloway)**. In addition, Ginter further teaches a document handler/destroyer 4115 may be provided to feed multi-page documents into document reader/scanner 4114 and--in one embodiment--to destroy documents to ensure that only one "original" exists at a time. Such controlled document destruction might, for example, be useful in allowing sender 4052 to deliver an original stock certificate to a transfer agent. **The sender 4052 could insert the original certificate into appliance 600--which may scan the original to convert it to digital information (e.g., through use of OCR technology), confirm delivery, and then destroy the original paper version (emphasis added).** Secure controls 4078 could be used to

ensure that only a single original ever exists on paper (column 30, lines 17-30 of Ginter). Thus the combination of teaching between Botham, Ginter, and Holloway teaches the claimed invention.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the combination of teaching between Botham, Ginter, and Holloway teaches the claimed invention and the combination of these prior arts is proper.

Botham, Ginter, and Holloway do not need to disclose anything over and above the invention as claimed in order to render it unpatentable or anticipate. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claimed limitations.

The fact that Examiner may not have specifically responded to any particular arguments made by Applicant and Applicant's Representative, should not be construed as indicating Examiner's agreement therewith.

For the above reasons, it is believed that the 35 USC 101 rejection for claims 33-39; and 35 USC 103 rejection for claims 1-2, 4-8, and 10-11 should be sustained.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 19-22, 33-39 are rejected under 35 U.S.C. 112, first paragraph, as based on a disclosure which is not enabling. "A system of the recipient assuring that the system of the recipient has received transmission of the copy of the original document" critical or essential to the practice of the invention, but not enabled by the disclosure. See *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976). Applicant cites new limitation as mentioned above in claims 19, 33, and 35, however, this new limitation does not clearly support by the specification. Appropriate correction is required.

Claims 19-22, 33-39 also are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Applicant cites new limitation as mentioned above in claims 19, 33, and 35, however, this new limitation does not clearly support by the specification. Appropriate correction is required.

Claim Rejections - 35 USC § 101

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6. Claims 33-39 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

a. Referring to claim 33:

i. Claim 33 recites "A computer-readable medium having a program available thereon for causing a suitably programmed information-handling system to transport documents between a first imaging device and a second imaging device by performing the following when such program is executed on the information-handling system: encrypting an original document; transmitting the original document from the first imaging device to the second imaging device, such that the second imaging device receives an image of the original document, wherein the second imaging device is under control of the recipient; transmitting an acknowledgment of

receipt of an the image of the original document from the second imaging device; and destroying the original document at the first imaging device in response to receiving the acknowledgment from the second imaging device, such that the original document is destroyed at the first imaging device only after the first imaging device has been assured that the second imaging device has received the image of the original document.” The claim is directed toward a software program, and this is a non-statutory subject matter. Furthermore, applicant has pointed out in the specification (see page 2, lines 19-24 of specification) **“the functions described herein are implemented in software in one embodiment, where the software comprises computer executable instructions stored on computer readable media such as memory or other type of storage devices. The term “computer readable media” is also used to represent carrier waves on which the software is transmitted. Further, such functions correspond to modules, which are software, hardware, firmware of any combination thereof,”** which clearly including intangible media such as signals, carrier waves, transmissions, optical waves, transmission media or other media incapable of being touched or perceived absent the tangible medium through which they are conveyed. Therefore, claim 33 recites a non-statutory subject matter.

b. Referring to claim 35:

i. These claims consist a apparatus for transporting a document to implement claim 33, thus they are rejected with the same rationale applied against claim 33 above.

c. Referring to claims 34, 36-39:

i. These claims are dependent claims of 33 and 35, thus they are rejected with the same rationale applied against claims 33 and 35 above.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1-2, 4-8, 10-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Botham et al (US 6,785,812 B1), in view of Ginter et al (US 6,185,683 B1), and further in view of Holloway et al (US 5,912,974).

a. Referring to claim 1:

i. Botham teaches a method of transporting a document comprising:

(1) encrypting an original document; transmitting an image the original document to a system of a recipient (**see Figure 2 and column 2, lines 6-12 of Botham**); assuring that the system of the recipient has received transmission of the image of the original document (**see last sentence of the abstract of Botham and column 2, lines 32-34; column 4, lines 9-10 and lines 34-35 of Botham**);

(2) destroying the original document at a system of a sender after transmitting the image of the original document to the system of recipient, where the original document is destroyed at the system of the sender only after the system of the sender has received assurance that the system of the recipient transmission of the image of the original document (**column 4, lines 9-10 and lines 34-35 of Botham**);

(3) decrypting the image of the original document (**see Figure 2 and column 2, lines 14-15 of Botham**);

(4) printing a copy of the image of the original document at the system of the recipient (**column 2, lines 50-54 of Botham**); and

(5) certifying that the copy of the image of the original document was received from a sender, by at least a public notary notarizing the copy of

the image of the original document as has been printed (**column 2, lines 32-34 of Botham**).

ii. Although Botham teaches the claimed subject matter, Botham is silent on the capability of showing the destroyed document is at the system of the sender and by at least a public notary notarizing the copy of the image of the original document. On the other hands, Ginter teaches the original document is destroyed at the system of the sender only after the system of the sender has received assurance that the system of the recipient transmission of the image of the original document (**column 8, lines 12-14 of Ginter**) and Holloway teaches by at least a public notary notarizing the copy of the image of the original document (**column 1, lines 21-22 of Holloway**).

iii. It would have been obvious to a person having ordinary skill in the art at the time the invention was made to:

(1) have modified the invention of Botham with the teaching of Ginter and Holloway to improve the electronic distribution of information (**column 1, lines 6-7 of Botham**).

iv. The ordinary skilled person would have been motivated to:

(1) have modified the invention of Botham with the teaching of Ginter and Holloway for securing and controlling electronic document distribution arrangement (**see Botham's tile**).

b. Referring to claim 2:

i. Botham further teaches:

(1) assuring that the system of the recipient is enabled to receive a transmission (**column 2, lines 32-34 of Botham**).

c. Referring to claim 4:

i. Botham further teaches:

(1) placing the received transmission in a storage device of the system of the recipient, wherein the public key of the sender is used by the

recipient to access the image of the original document in the storage device (**column 2, lines 1-5 of Botham**).

d. Referring to claim 5:

i. Botham further teaches:

(1) adding a global universal identification to the encrypted original document (**column 4, lines 10-18 of Botham**).

e. Referring to claim 6:

i. Botham further teaches:

(1) wherein the global universal identification includes a time component and a unique machine identifier (**column 4, lines 10-18 of Botham**).

f. Referring to claim 7:

i. Botham further teaches:

(1) wherein the unique machine identifier is a machine address code (MAC) (**column 4, lines 10-18 of Botham**).

g. Referring to claim 8:

i. Botham further teaches:

(1) notarizing the original document (**column 4, line 16 of Botham**).

h. Referring to claim 10:

i. Botham further teaches:

(1) wherein encrypting an original document further comprises use of a private key of the sender (**column 2, lines 1-5 of Botham**).

i. Referring to claim 11:

i. Botham further teaches:

(1) wherein encrypting an original document further comprises use of a public key of a recipient (**column 2, lines 1-5 of Botham**).

9. Claims 19-22 and 33-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Botham et al (US 6,785,812 B1), and further in view of Walforst (US 6,731,411 B1)

a. Referring to claim 19:

i. This claim consists an imaging apparatus to implement claim 1, thus it is rejected with the same rationale applied against claim 1 above.

ii. Although Botham teaches the claimed subject matter, Botham is silent on the capability of verifying/assuring the system of the recipient has received the original document. On the other hand, Walforst teaches this limitation in Figures 1-2 and 5 and more details in column 2, lines 3-13 of Walforst.

b. Referring to claims 20-22:

i. These claims have limitations that are similar to those of claims 1-4, thus they are rejected with the same rationale applied against claims 1-4 above.

c. Referring to claims 33-34:

i. These claims consist a computer-readable medium having a program available thereon for causing a suitably programmed information-handling system to transport documents between a first imaging device and a second imaging device by performing the following when such program is executed on the information-handling system to implement claims 1, 4, and 19, thus they are rejected with the same rationale applied against claims 1, 4, and 19 above.

d. Referring to claims 35-39:

i. These claims consist an apparatus for transporting a document to implement claims 1-4 and 19, thus they are rejected with the same rationale applied against claims 1-4, and 19 above.

Conclusion

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thanhnga (Tanya) Truong whose telephone number is 571-272-3858.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kim Vu can be reached at 571-272-3859. The fax and phone numbers for the organization where this application or proceeding is assigned is 571-273-8300.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 571-272-2100.

/Thanhnga B. Truong/

Primary Examiner, Art Unit 2135

TBT

July 18, 2008

